

REMARKS

The claims are 22-42, with claims 22, 26, 31, 36 and 41 being independent. Support for new claims 22-42 may be found original claims 1-21. No new matter has been added.

Claims 1-21 were objected to for allegedly containing non-elected subject matter, specifically subject matter drawn towards non-elected subject matter. Applicants have interpreted the Examiner's restriction to "optionally substituted furan" to mean "optionally substituted furan-C₀₋₆alkyl." Accordingly, new claims 22-41 are directed to triazole compounds of Formula (I) and (IA) wherein X is S, R¹ is optionally substituted furan-C₀₋₆alkyl, R² is optionally substituted Ar-C₀₋₆alkyl, and R³ is H, optionally substituted C₁₋₆alkyl, C₃₋₆alkenyl, C₃₋₆alkynyl.

Claims 1-15 were rejected under 35 U.S.C. 112, first paragraph, as allegedly not enabled. The Examiner further contends that one skilled in the art would have to engage in undue experimentation, with no assurance of success, to practice the claimed invention. Applicants respectfully traverse this rejection as well as the Examiner's conclusion as to undue experimentation.

The requirement for enablement is described in MPEP § 2164.01(b):

"As long as the specification discloses at least one method of making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied."

Applicants respectfully submit that the subject specification fulfills these requirements. The subject specification provides more than at least one method of making a compound of this invention. Procedures for the preparation of over 300 compounds have been provided in the subject specification. The subject specification provides more than at least one method of using the claimed invention. As recited in the first sentence of the specification and in the Detailed Description, the 1,2,4-triazoles of the subject invention are useful as inhibitors of MetAP2. Test methods for assessing the degree to which a specific compound of this invention inhibits MetAP2 are disclosed at pages 97-99 and cell growth inhibition assays are described at pages 99-100.

"Enablement is not precluded by the necessity for some experimentation such as routine screening." *In re Wands* 858 F.2d 731,737 (Fed. Cir. 1988)

Applicants respectfully submit that the synthesis of a compound falling within the scope of the claimed generic structure using the methods analogous to those described and the screening of the compound using at least one of the methods described constitute no more than routine experimentation.

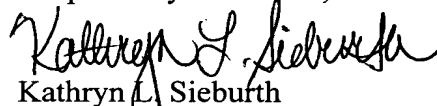
The Examiner contends that "one of skill in the art is not able to fully predict possible results" from the use of the subject claimed compounds "due to the unpredictability of the role of MetAP2 in disease treatment and prevention and the unpredictability of the structure/activity relationship for the compounds of the invention and the inhibition of MetAP2." Contrary to the Examiner's assertion, there is no requirement that the "full" structure/activity relationship be established for all compounds falling within a generic structure to satisfy the enablement requirements. The courts simply do not require that an application for patent enable one of skill in the art to predict all possible results - "the law does not require a specification to be a blueprint in order to satisfy the requirement for enablement under 35 U.S.C 112, first paragraph," *Staehelin v. Secher*, 24 USPQ2d 1513, 1516 (BPAI 1992).

Applicants respectfully submit that the background art cited in the specification adequately supports the claims to the therapeutic value of inhibition of MetAP2. Two additional recent references are submitted herewith to provide further support for Applicants claims.

Applicants respectfully submit that the subject specification satisfies the requirements for enablement and that the subject application is in condition for allowance. If the Examiner has any objections or concerns, the Examiner is respectfully requested to contact Applicants' undersigned attorney to resolve such issues and advance the case to issue.

This Amendment is being filed together with Petition for Extension of Time. In the event that these papers get separated, this constitutes a Petition for Extension of Time for the minimum period required to effect timely filing of this Amendment, together with an authorization to charge any fees under 37 C.F.R. §1.16 or §1.17 which may be required by this paper to Deposit Account No. 19-2570.

Respectfully submitted,


Kathryn L. Sieburth
Attorney for Applicants
Registration No. 40,072

GLAXOSMITHKLINE
Corporate Intellectual Property-UW2220
P.O. Box 1539
King of Prussia, PA 19406-0939
Phone: (610) 270-5012
Facsimile: (610) 270-5090
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